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| 10/003,471            | 10/31/2001  | Matthew W. Hickey    | C063                | 4349             |
| 25784                 | 7590        | 11/07/2007           |                     |                  |
| MICHAEL O. SCHEINBERG |             |                      | EXAMINER            |                  |
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| AUSTIN, TX 78716-4140 |             |                      |                     |                  |
|                       |             |                      | ART UNIT            | PAPER NUMBER     |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/003,471 | <b>Applicant(s)</b><br>HICKEY ET AL. |  |
|                              | <b>Examiner</b><br>Jean Janvier      | <b>Art Unit</b><br>3622              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### **Response To Applicant's Arguments**

First of all, the Examiner's objection to the title is clear as previously stated and updated herein.

Second, and in general, the Applicant has failed to clearly point out the salient or novel feature of his invention. Indeed, the argued limitations, as herein presented, are either explicitly or implicitly supported or expected in the primary reference or in the systems outlined by the Examiner under the "Office Notice". For example, the Applicant argues that the prior art or Ireland (the primary reference) does not teach "providing a form for use in nominating a scholarship recipient nominee", "contacting the nominee to confirm that the nominee accepts the nomination" or "confirming the vote using electronic mail". In general, Ireland teaches, inter alia, a system for allowing students to apply for a college/university online via a website and providing/transmitting by a plurality of colleges/universities over a computer network or the Internet financial award information including **scholarship information** to potential students. Furthermore, Ireland discloses a system wherein following a clearing process, **a school administrator 60, from a particular school, preferably mails a letter to a potential student 50, which contains an announcement that a financial aid award package, including a scholarship award, has been granted to that student 50, meeting or satisfying one or more conditions or requirements or criteria (e.g. the student 50 has applied to the school), and may be obtained by visiting the website on the computer network 20. The letter preferably contains a URL address, user name and password (col. 6: 29-34).** Needless to say here that Ireland implicitly supports the steps of selecting an award recipient or a scholarship recipient, after a clearing process (which may include a voting process), based on one or more criteria. At

Art Unit: 3622

**this point, although Ireland does not expressly recite the argued limitations as featured above, however, those limitations are well documented in the art or practiced in the industry for many years well before the Applicant's invention and are featured here in the "Official Notice". Thus, incorporating the "Official Notice" into the system of Ireland does indeed render the claimed invention obvious by improving, via a voting process, the selection or clearing process used to select a financial award recipient or scholarship recipient, while making the selecting or clearing process fair and square.**

Additionally, it appears that the claimed invention, as herein presented, is at best an automation of traditional scholarship award methods. Here, the Examiner wants to remind the Applicant that a pure automation of a well-known process is not patentable.

Moreover, regarding the "Official Notice", the concept of conducting (political) elections online/Internet was widely discussed in the media well before the Applicant's invention. It also appears that the Applicant is challenging the "Official Notice". However, simply requesting a written document in support of an "Official Notice" because the Applicant disagrees with the Examiner's assertion featured therein without pointing out the deficiency in the said "Official Notice" is never proper. If the Applicant is not familiar with the well-documented systems discussed in the "Official Notice", the Applicant should "say so" on the record. Having said that, the Examiner herein includes some printouts from the NBA.com site to show that voting on the Internet has been practiced in the art before the present invention.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the

Art Unit: 3622

Applicant's arguments as herein presented are not plausible and thus, the last Office Action, as shown below, is hereby maintained and the current **Office Action has been made Final**.

### **DETAILED ACTION**

#### ***Specification***

The title of the invention is not descriptive so as to help one having ordinary skills in the art understand the nature of the subject matter. A new title is required that is clearly indicative of the invention to which the claims are directed. Further, the title of the invention, under 37 C.F.R. 1.72, should be descriptive, brief and technically accurate.

#### ***Claim Status***

Claims 1-18 are herein being examined.

#### **General Comments**

All scholarships have requirements, conditions or eligibility criteria that a candidate or a recipient must satisfy before he/she can receive a scholarship award.

**Regarding claims 1 and 6, in the step of "confirming the vote using electronic mail", it is unclear how the confirming by e-mail is being performed or important elements, necessary to help understand the claim limitation, are missing therefrom ("who is the e-mail sender and recipient").**

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

Art Unit: 3622

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-18 are rejected under 103(a) as being unpatentable over Ireland, USP 7,062,462B1.

As per claims 1-18, Ireland discloses a method of providing a user with education financing information, including the acts of: maintaining an electronic site on a computer network to which the user may connect; sending data to the user over the network for presenting at least one electronic screen containing financial award information concerning a potential student of an educational institution, the financial award information including a monetary award (scholarship award) which may be used for the student to attend the educational institution and sending data to the user over the network when requested for presenting at least one electronic screen containing cost projection information, the cost projection information being a function of the award and including an amount of money required for the student to attend the educational institution (See abstract; ).

Art Unit: 3622

In general, many individuals require financial assistance in paying for an education, whether it be in the form of grants, scholarships, special employment (e.g., work-study programs), and/or loans. Many such educational institutions (e.g., schools, such as colleges and universities) provide various forms of assistance in obtaining financial aid for potential students (col. 1: 24-38). Financial aid office of schools, colleges and universities will mail many financial aid award packages (scholarship awards) to potential students with the hope that the financial aid award is attractive to the student and that the student will accept the award and attend the school. The cost for mailing many financial aid award packages can be substantial. For instance, each package may cost approximately \$10.00 to mail to 1000 potential students. Accordingly, schools are interested in other modes of transmitting financial aid award packages to their potential students, which are less costly (col. 1: 39-49). Further, a system called CollegeNET has been developed and offered by Sallie Mae, which provides a system for presenting financial award (including scholarship awards) information over the Internet to potential students. A particular school mails an award letter to a potential student, which includes a user name and password to access a secure website. The student logs onto the website and accesses their financial aid award package. The student can choose a preferred lender if a loan is awarded and input other information necessary for accepting the award. The student's response to the award is reported to the school (col. 2: 32-41). Students obtain financial aid based on need or merit or a combination thereof (col. 2: 60-62; col. 3: 1-17).

(See col. 3: 20 to col. 5: 14).

**A plurality of school administrators 60 from a plurality of schools transmit financial award information, including scholarship award information, from their respective schools**

Art Unit: 3622

**over the computer network 20 (Internet) concerning the potential students 50 (prospective scholarship recipients). The microprocessor 12 and network interface 16 preferably respond by sending data over the network 20 for presenting at least one electronic screen (i.e., an electronic file containing information suitable for presentation to the students/parents 50), which contains the financial award information (fig. 1; col. 6:10-28). Next, following a clearing process, a school administrator 60, from a particular school, preferably mails a letter to a potential student 50, which contains an announcement that a financial aid award package, including a scholarship award, has been granted to that student 50, meeting or satisfying one or more conditions or requirements or criteria (e.g. the student 50 has applied to the school), and may be obtained by visiting the website on the computer network 20. The letter preferably contains a URL address, user name and password (col. 6: 29-34).**

Once a student/parent successfully logs into the system website, the process flow and control causes the network server 10 to provide data presenting an electronic screen (interface) to the student/parent 50 representing the home page of the website (FIG. 3B). The home page includes an area 312, which identifies the student 50 by name, student ID or social security number, address, and telephone number. The name of the school may be provided at area 314 and a welcome message from that school may be included in area 316. With reference to FIGS. 3B, 2B and 2C, area 318 provides links to other portions of the website, in **particular: (i) instructions on how to use the application** may be activated and reviewed (step 238); (ii) a link to the student's 50 award package may be activated (step 210, FIG. 2C); (iii) a link to the policies, rules, and/or regulations for financial aid and scholarships may be activated (step 232) (iv) **a link to information about the school may be activated** (step 240); (vi) a link to security



Art Unit: 3622

information about the website may be activated (step 244); and (vii) a link to additional information about the school, such as promotional material, may be activated (step 246) (in short, the student/parent fills out an electronic form or application for a scholarship award via a website over the Internet) . See col. 7: 11-31). Preferably, the amounts of grants 322A of fig. 3C, scholarships 322B, jobs 322C and loans 322D for at least individual school terms, school years, and totals for the school year 322E are featured on the website. Subtotals for the grants, scholarships, jobs, and loans are also preferably provided. At 322F, a total award package amount is provided which indicates the amount of award money, which may be utilized by the student 50 to attend the school for the entire school year (fig. 3C; col. 7:41 to col. 8: 6).

As per claims 1, 2, 4, 5, 6, 7, 8, 9, 10, 12, 13 and 14-18, Ireland does not expressly disclose nominating or voting for one or more scholarship recipients via an online form, contacting the one or more nominees to confirm that they accept the nomination (or contacting the one or more nominees to notify them that they have been nominated for a scholarship award), transmitting a confirmation of the vote by e-mail, preventing a voter from voting multiple times and awarding a scholarship to the (first) recipient or nominee who receives the most votes or a predetermined number of votes.

However, the process of receiving by a center or a committee from a person (voter) a nomination on behalf of another person or recipient (second person or nominee) is old and well established in the art for many years. For example, the process by which elected officials are elected in a democratic system or country, such as the USA, allows one or more registered individuals or voters to visit a local voting location to vote for a single candidate (second person)

Art Unit: 3622

among a plurality of candidates running for the same post or office (US Senate) during the primary or general elections, wherein the candidate with the most votes will win the race or the post (award or reward) and have a chance to serve or represent his constituency in Washington, D.C (The Nation's Capital). In general, despite some pitfalls, the system is considered to be for the most part fair and square. An election committee collects the votes from different local voting places and local precincts and sorts out and tabulates and presents the final results. As the results are coming from different local precincts in different districts, it could be clear who the winners are going to be. Moreover, nominating a singer, an actor (actress or nominee) in different categories for a Tony Award or Grammy Award, nominating an individual to receive a "Nobel Prize" (Nobel Peace Prize or Nobel Prize in Literature, medicine etc.), nominating a teacher for the "Teacher of the Year Award" and nominating a fellow worker or employee by other employees for the employee of the month or the year depict one or more methods for receiving by a committee a nomination from a first person for recognition for a second person (nominee) so as to provide an award or a prize to the nominee or second person if the nominee collects the most votes to thereby win the nomination.

Furthermore, it has been disclosed that local, State-wide, primary and general elections can be conducted over the Internet, wherein a voter, using a computer, can vote or nominate a candidate or a second person for a post or a position in the privacy of his own home. One having ordinary skills in the art would have understood that the election committee would have to use a server or web server (election server) connected to the Internet in order to receive the nominations or the votes from one or more voters on behalf of one or more candidates, wherein

Art Unit: 3622

the one or more voters could use clients or personal computers coupled to the Internet to access a web site related to the election server in order to vote for one or more candidates.

In addition, it is well established in the industry, for example, that the National Basketball Association (NBA) receives nominations, via a form posted on its site, for players for different posts who will compose the All-Star Western and Eastern squads, nominations for the most valuable player (MVP) of the year or the Western and Eastern Conference Final or the NBA final, from individuals who access, using their clients or personal computers, the NBA web site having a web server for storing the various data or nominations submitted by these individuals or voters.

Additionally, a process to notify a winner in a primary or general election, a Nobel Peace Prize winner, the NBA MVP of the year, etc., is well expected in each of the scenarios described above. It is also understood that many intervening steps, agencies and officials or committee members may be involved in the different scenarios herein mentioned.

Moreover, the number of clients or personal computers and servers used (the amount of hardware) and the number of people or committee members or personnel involved in the decision making process to approve or reject a nomination for "The teacher of the Year Award" or the "Nobel Peace Prize", for instance, vary from one committee to another and are unique and dependent upon a committee's desires. Here, it is expected that a nominee for an award, such the "Tony Award", or a prize, such as the "Nobel Peace Prize", will be notified that he/she has been nominated for such an award or prize.

It is also common practice in the art that College Applicants are given a chance to receive a scholarship based one or more criteria including the writing of an essay in the end. The

Art Unit: 3622

selection process or the winner(s) of the scholarship is performed via a nomination process.

During the process, Applicants who are qualified to continue to compete for the scholarship receive an invitation or a notification, which is posted on a website.

In general, in all voting procedures, the candidate or nominee with the most votes wins.

Finally, it is well documented in the art to confirm a purchase or any other type of transaction, such as registering for an event, participating in a contest, etc., via e-mail.

“Official Notice”

Therefore, an ordinary skilled artisan, knowing the above information, would have been motivated at the time of the invention to incorporate the above disclosure (“Official Notice”) into the Ireland’s system so as to have a committee or a plurality of voters vote for one or more scholarship candidates by submitting their votes or ballots, via an online form, on behalf of the one or more prospective recipients or candidates, wherein an e-mail confirmation process is used to confirm the vote and wherein a notification process is used to announce the winner(s), meeting the eligibility criteria and receiving the most votes, of a particular scholarship related to a specific school, thereby reducing the school or grantor’s liability by conducting a nomination and voting process to determine from a pool of prospective recipients the most aspiring scholarship candidates, satisfying the eligibility requirements and receiving the most votes, who should in the end receive a scholarship award to attend a specific school selected by the candidates, especially when resources are scarce and a lot of respondents have shown interest in the scholarship, in response to the school administrator’s invitation or letter to offer a scholarship to students willing to attend the school, by visiting an associated website where they can receive

Art Unit: 3622

more information about the scholarship featured in the administrator's invitation or offer before the nomination or voting actually takes place.

As per claim 11, Ireland does not expressly teach posting a list of nominee identifiers to identify a nominee to a voter, the identifier not revealing the name or address of the nominee.

However, as shown above, a list of the candidates is posted online in order for the voters to vote for at least a candidate for a particular position (NBA scenario). It also common practice to post a list of identifiers or pseudonyms, instead of individuals' real names, in a "buddy list", thereby protecting the individuals' privacy, while maintaining confidentiality. "Official Notice"

Therefore, an ordinary skilled artisan, knowing the above information, would have been motivated at the time of the invention to incorporate the above disclosure ("Official Notice") into the Ireland's system so as to post online a list of identifiers or pseudonyms, representing scholarship candidates' or nominees' real names, and to have a committee or a plurality of voters vote for one or more nominees by selecting one or more related identifiers therefrom, thereby protecting the individuals' or nominees' privacy and maintaining confidentiality, while keeping the selection or decision process fair and square by avoiding nepotism or favoritism since the voters do not know the real names of the nominees for whom they are voting for, but their credentials or accomplishments.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3622

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

10/24/07

JDJ

**Jean D. Janvier**  
**Patent Examiner**  
Art Unit 3622

JEAN D. JANVIER  
PRIMARY EXAMINER

